

## **REMARKS**

Applicant is in receipt of the Office Action mailed May 14, 2004. Reconsideration of the present case is earnestly requested in light of the following remarks.

### **§101 Rejections**

Claims 11-17 were rejected under 35 U.S.C. 101 as the Office Action asserts: “. . .because the claimed invention is directed to non-statutory subject matter. A memory medium comprising program instructions does not represent statutory subject matter.” This rejection is respectfully traversed.

As Examiner is certainly aware “. . .a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory” as stated in the MPEP §2106 IV.B.1(a) (*emphasis added*).

Applicant has amended claims 11-12 to more fully and completely claim Applicant's invention. Accordingly, Applicant respectfully submits Applicant respectfully submits that claims 11-12 and those, respectfully, dependent therefrom are allowable.

Applicant respectfully requests removal of the §101 rejections.

### **§103 Rejections**

Claims 1-8, 11-16, and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Meth et al. (U.S. Pat. No. 6,401,216 B1, hereinafter “Meth”) in view of Hansen (U.S. Pat. No. 6,128,759). This rejection is respectfully traversed.

Applicant respectfully submits that there is no teaching, suggestion, or motivation to combine Meth and Hansen in either of the references or in the prior art. As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. Furthermore, Applicant respectfully submits that it is nonobvious to combine Meth and Hansen.

Furthermore, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular. . .Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination. Applicant respectfully submits that there is no suggestion in the prior art for combining Meth and Hansen, and that even were the two references combined, they would not produce Applicant’s invention as recited in independent claims 1, 11, 18, and 20.

Applicant respectfully submits that a *prima facie* case of obviousness is not established to reject independent claims 1, 11, 18, and 20, based on the following reasoning. Meth teaches a system and a method for operating a parallel program (Meth Abstract) while Hansen teaches “. . .the selected test program is run, the steps specified in the corresponding tree are run in sequence. . .” (Hansen col. 15, lines 2-4) (*emphasis added*). Applicant respectfully submits that there is no reasonable expectation of success in combining Meth and Hansen.

If Meth and Hansen can be combined, then the combination would produce a test program for automatically test equipment which must use a parallel program which must contain multiple processes which are executed independently (Meth col. 1, lines 44-45). However, Hansen teaches and discloses that a test program must be executed sequentially: “When the selected test program is run, the steps specified in the

corresponding tree are run in sequence, starting with the root node and continuing with the child nodes until all end leaves in the hierarchical tree are executed” (Hansen col. 15, lines 2-6) (*emphasis added*). Furthermore, Hansen nowhere provides teaching, evidence, suggestion, or motivation to execute any two or more parts or portions of a test program in parallel.

As Examiner is certainly aware “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)” as stated in the MPEP §2142 (*emphasis added*).

Furthermore, Applicant respectfully submits that executing any two or more parts or portions of a test program (as described in Hansen) in parallel would change the principle of operation of Hansen. Moreover, Applicant respectfully submits that Hansen does not teach, suggest, or motivate execution of a test program can be resumed from any point at which execution was stopped or halted, outside of a debugging process (col. 13, line 65 - col. 14, line 27 and col. 15, lines 1-8). Thus, modifying Hansen such that execution of a test program can be resumed from a point at which execution was stopped or halted outside of a debugging process would change the principle of operation of Hansen.

As Examiner is certainly aware that the MPEP §2143.01 states, “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* , 270 F.2d 810, 123 USPQ 349 (CCPA 1959). . .” (*emphasis added*).

Moreover, because Hansen teaches “. . .the selected test program is run, the steps specified in the corresponding tree are run in sequence. . .” (Hansen col. 15, lines 2-4) (*emphasis added*), Applicant respectfully submits modifying Hansen such that executing any two or more parts or portions of a test program (as described in Hansen) in parallel can occur would render Hansen unsatisfactory for its intended purpose.

As Examiner is certainly aware, “If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). . .” as stated in the MPEP §2143.01 (*emphasis added*).

Accordingly, Applicant respectfully submits that, for at least one or more reasons presented, a *prima facie* case of obviousness is not established to reject independent claims 1, 11, 18, and 20.

Accordingly, Applicant respectfully submits that, at least for one or more reasons presented, independent claims 1, 11, 18, and 20 and those, respectfully, dependent therefrom are allowable.

Applicant respectfully submits that Meth and Hansen are nonanalogous art to each other, based on the following reasoning. As mentioned above, Meth teaches a system and a method for operating a parallel program (Meth Abstract) while Hansen teaches “. . .the selected test program is run, the steps specified in the corresponding tree are run in sequence. . .” (Hansen col. 15, lines 2-4) (*emphasis added*).

Thus, Applicant respectfully submits that differences in structure and function between a parallel program and a test program where the steps are run in sequence are too great.

As Examiner is certainly aware “While Patent Office classification of references and the cross-references in the official search notes are some evidence of “nonanalogy” or “analogy” respectively, the court has found “the similarities and differences in structure

and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973)" as stated in the MPEP §2141.01(a) (*emphasis added*).

Accordingly, Applicant respectfully submits that that Meth and Hansen are nonanalogous art to each other and cannot be combined to reject claims 1, 11, 18, and 20.

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meth and Hansen in further view of Stiffler (U.S. Pat. No. 5,864,657). This rejection is respectfully traversed.

Various of the independent claims have been argued to overcome rejections under 35 U.S.C. 103(a) of Meth in view of Hansen. Applicant respectfully submits that various of the independent claims are nonobvious in further view of Stiffler and are allowable, as well. Applicant respectfully submits: "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)" as stated in the MPEP §2143.03. Accordingly, Applicant respectfully submits that, at least for one or more reasons presented, claims 1-20 are allowable.

Claims 10 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Meth and Hansen in further view of Shirakihara et al. (U.S. Pat. No. 6,185,702, hereinafter "Shirakihara"). This rejection is respectfully traversed.

Various of the independent claims have been argued to overcome rejections under 35 U.S.C. 103(a) of Meth in view of Hansen. Applicant respectfully submits that various of the independent claims are nonobvious in further view of Shirakihara and are allowable, as well. Applicant respectfully submits: "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)" as stated in the MPEP §2143.03. Accordingly, Applicant respectfully submits that, at least for one or more reasons presented, claims 1-20 are allowable.

Applicant also respectfully submits that numerous ones of the dependent claims recited further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

Applicant respectfully requests removal of the §103 rejections.

## CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-50100/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Request for Approval of Drawing Changes
- ☐ Notice of Change of Address
- ☐ Check in the amount of \$            for fees (        ).
- ☐ Other:

Respectfully submitted,



---

Jeffrey C. Hood  
Reg. No. 35,198  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert & Goetzel PC  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8800  
Date: 8/16/2004 JCH/MSW/IMF